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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/521,887	SEVILLA, JORGE ABELLAN
	Examiner	**Art Unit**	
	Aleksandr Kerzhner	2169	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _30 April 2007_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _14-24_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _14-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _30 August 2007_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/30/2007 has been entered.

This Office action has been issued in response to supplemental amendment filed 09/06/2007. Claims 1-13, 20 and 22-24 are canceled. Claims 14-19 and 21 are pending.

Applicants arguments and amendments have been carefully and respectfully considered in light of the instant amendment and are persuasive, except as they relate to the drawing objection (see bellow). In view of Applicants arguments and amendments, 35 USC 101 (Office action mailed 05/30/2007, pages 6-8, para. 5) and 35 USC 112 rejections of claims (Office action mailed 05/30/2007, pages 8-12, para. 6-11), objection to the drawings (Office action mailed 05/30/2007, pages 3-4, para. 1 and 2) and to the claims (Office action mailed 05/30/2007, page 6, para. 4) are withdrawn.

This action is Non-Final.

Drawings

1. The receipt of the replacement drawings filed on 08/30/2007 is acknowledged.

2.   The drawings (Figure 2) are objected to under 37 CFR 1.83(a). The drawings

must show every feature of the invention specified in the claims. Therefore, the "storing

a synchronization object as a last synchronization object," "generating ... a new

synchronization object," "storing the new synchronization object," "reading the new

synchronization object," "comparing the new synchronization object," "modifying at least

one of the first and the second databases," "notifying the removable subscriber identity

module," "removable subscriber identity module provides the last synchronization object

and the new synchronization object," and etc. must be shown or the feature(s) canceled

from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next

Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 14-16 and 21are rejected under 35 U.S.C. 103(a) as being unpatentable

over Novak et al., US Patent Application Publication No. US 2003/0037020 A1

(Hereinafter "Novak et al.") in view of Proust et al., US Patent No.: US 6,367,014 B1

(Hereinafter "Proust et al.").

Regarding **claim 14**, Novak et al. shows:

A method for synchronizing a first database with a second database in a system

comprising: (Abs)

Storing a synchronization object (*checksum, [0030]*) as a last synchronization

object associated with the first database in a memory of a removable subscriber identity

module (*Fig 2 #50*) after a first synchronization of the first and second database (*"The*

calculated checksum can then be stored and used to aid in tracking changes to the

database stored in the memory 180, e.g., a SIM card." See e.g., [0030]), wherein the

last synchronization object indicates a state of the first database before any

modifications to the first database are made after the first synchronization (*Use of*

checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]);

Generating a new synchronization object associated with the first database when the removable subscriber identity module receives a request that the new synchronization object be associated to the first database (*"However, the checksum can be calculated and stored in the device as the DID at other times. Examples include: when a receiving device requests the change log or DID for purposes of synchronization," see e.g. [0031]);* and

Storing the new synchronization object in the memory of the removable subscriber identity module (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030], [0032]*)

Novak et al. does not expressly disclose:

That such generating is done "by the removable subscriber identity module".

However, Proust et al. teaches:

That a subscriber identity module can generate a checksum. (*checksum calculation by a SIM card, see e.g., Col 11, lines 48-54 and Col 12, lines 27-29*)

Novak et al. teaches a method of synchronizing a SIM card with a database. Novak et al., uses checksums as synchronization objects which are stored inside the memory of the SIM card. Novak et al. does not expressly disclose if the SIM card generates the checksums.

Proust et al. teaches that generation of checksum by the SIM card is a known

technique.

Thus, it would have been obvious to one of ordinary skill in the art to apply the

technique of generating a checksum by the SIM card as taught by Proust et al., to

improve the synchronization of data stored on the SIM card of Novak et al. for the

predictable result of generating a checksum of the data stored in the SIM card.

Regarding **claim 15**, Novak et al. in view of Proust et al. shows:

Reading the new synchronization object associated with the first database when

the new synchronization is requested between the first and the second database;

(*Novak et al.: see e.g., [0032], Fig 6B*)

Comparing the new synchronization object associated with the first database with

a synchronization object associated with the second database; (*Novak et al.: see e.g.,*

[0032], Fig 6B) and

Modifying at least one of the first and the second databases to synchronize the

first database with the second database when a comparison between the new

synchronization object associated with the first database and the synchronization object

associated with the second database indicates that the first and the second database

have been previously synchronized and modifications have occurred since the previous

synchronization. (*Novak et al.: see e.g., [0032], Fig 6B*)

Regarding **claim 16**, Novak et al. in view of Proust et al. shows:

Notifying the removable subscriber identity module when the new

synchronization is initiated between the first database and the second database, (*Novak*

et al.: requesting DID for purposes of synchronization, see e.g. [0031])

Wherein the removable subscriber identity module provides the last

synchronization object and the new synchronization object; (*Novak et al.: calculating*

checksum before synchronization and after, see e.g. [0031]) and

Wherein the new synchronization object is stored as the last synchronization

object after the successful completion of the new synchronization of the first database

with the second database. (*Novak et al.: recalculating checksum and replacing DID with*

it, see e.g. [0031] and [0032])

Regarding **claim 21**, Novak et al. in view of Proust et al. shows:

A system comprising:

A plurality of devices, wherein at least one device from the plurality of devices is

a removable subscriber identity module; .(*"the present invention finds particular*

application to the synchronization of databases between devices wherein at least one of

the devices has a removable SIM card, e.g., a mobile phone," see e.g. [0022]);

Wherein the removable subscriber identity module is configured to communicate

with at least another device from the plurality of devices and adapted to comprise a first

database; (*See e.g. SIM communicating with mobile device Fig 2, mobile device*

communicating with SIM card Fig 6A) and

Wherein at least one device from the plurality of devices is adapted to comprise a

second database; (*See e.g. Fig 2 #40*) and

Wherein the removable subscriber identity module comprises,

A memory (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030]*),

A synchronization object stored as a last synchronization object associated with the first database in the memory after a first synchronization of the first and the second database; (*"The calculated checksum can then be stored and used to aid in tracking changes to the database stored in the memory 180, e.g., a SIM card." See e.g., [0030]*) and

A new synchronization object associated with the first database stored in the memory when the removable subscriber identity module receives a request for a second synchronization (*"However, the checksum can be calculated and stored in the device as the DID at other times. Examples include: when a receiving device requests the change log or DID for purposes of synchronization," see e.g. [0031]*);

Wherein the last synchronization object indicates a state of the first database before any modifications are made to the first database after the first synchronization. (*Use of checksum in synchronization, see e.g. [0032], "checksum associated with contents of the database," see e.g. [0033]*);

Novak et al. does not expressly disclose:

Wherein the removable subscriber identity module is configured to generate the new synchronization object.

However, Proust et al. teaches:

Wherein the removable subscriber identity module is configured to generate the new synchronization object. (*checksum calculation by a SIM card, see e.g., Col 11, lines 48-54 and Col 12, lines 27-29*)

Novak et al. teaches a method of synchronizing a SIM card with a database. Novak et al., uses checksums as synchronization objects which are stored inside the memory of the SIM card. Novak et al. does not expressly disclose if the SIM card generates the checksums.

Proust et al. teaches that generation of checksum by the SIM card is a known technique.

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of generating a checksum by the SIM card as taught by Proust et al., to improve the synchronization of data stored on the SIM card of Novak et al. for the predictable result of generating a checksum of the data stored in the SIM card.

4.   **Claims 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak et al. in view of Proust et al. further in view of Ahlgren et al. US Patent No. 6968209 B1 (Hereinafter "Ahlgren et al.").

Regarding **claim 17,** as set forth in the rejection of claim 14 above, Novak et al. in view of Proust et al. shows all the claimed limitations except, it does not expressly disclose that a removable device can be asked for its modifications.

However, Ahlgren et al. teaches that changes between change log stored on the device and changes made in SIM card can be synchronized (*Col 4, line 55 – Col 5, line 11*).

Novak et al. and Ahlgren et al. are analogous art because they are from the same field of endeavor of synchronizing SIM card with a database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to synchronize the device of Novak et al. in view of Proust et al. with the SIM card of Novak et al. in view of Proust et al. in order to speed up the synchronization, as taught by Ahlgren et al.

Motivation of doing so would be to enhance the synchronization (*See e.g. using checksum to enhance database synchronization, Ahlgren et al., Col 4, lines 55-58*)

Regarding **claim 18**, as set forth in the rejection of claim 17 above, Novak et al. in view of Proust et al. shows all the claimed limitations except, it does not expressly disclose that the device is able to make use of a local copy of the removable device memory.

However, Ahlgren et al. teaches that the device is able to make use of a local copy of the removable device memory (*Col 4, lines 24-29, checksum is stored both in the SIM and phone*) to obtain the database content and to follow with the data synchronization process.

Novak et al. and Ahlgren et al. are analogous art because they are from the same field of endeavor of synchronizing SIM card with a database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to store information on the device of Novak et al. in view of Proust et al. and in the SIM card of Novak et al. in view of Proust et al. in order to speed up the synchronization, as taught by Ahlgren et al.

Motivation of doing so would be to speed up the synchronization (*See e.g. "Thus, the synchronization process may be performed more rapidly," Ahlgren et al., Col 2, lines 29-30*)

5.   **Claims 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Novak et al. in view of Proust et al., in view of Applicants' Admitted Prior Art in the original disclosure (Hereinafter "AAPA").

Regarding **claims 19**, Novak et al. teaches all the limitations of claim 19 (See use of Novak et al. in rejection of claims 14 above) except, it does not expressly disclose device informing the removable device that the synchronization has been successfully performed.

However, AAPA discloses that it is known for both systems to exchange acknowledgment and finalization messages. (*See e.g., page 2, lines 12-13 of the specification in original disclosure*)

It would have been obvious to one having ordinary skill in the pertinent art at the time the invention was made that device of Novak et al. in view of Proust et al. can inform the removable device of Novak et al. in view of Proust et al. the success of the synchronization as taught by AAPA.

Motivation to do so would be to let the removable device know so it can recalculate the checksum and replace the old checksum by the new one.

6.   The prior art made of record and not relied upon is considered to be pertinent to applicant's disclosure:

Martineau, US Patent No.: 5,915,226, teaches that the SIM card can calculate a

random number.

Response to Arguments

Drawings

7.   Applicant's arguments with regard to objections to drawings have been fully

considered but they are not persuasive.

Applicant states:

"Applicant disagrees with the Examiner's statement that the features listed on

page 5 of the Office Action mailed on May 30, 2007, are not shown in the figures.

Specifically, Figure 2 references Steps 1-4. Steps 1-4 are described in detail on pages

6-8 of the specification. Accordingly, the claimed features are shown in the Figures.

Moreover, to the extent any of the claimed features are described in relation to Steps 1-

4, the Applicant respectfully asserts that the specification adequately describes the

elements of the claimed invention and, accordingly, a graphical depiction of the

elements in the drawings is not required. In view of the above, the Applicant asserts that

the drawings, as pending, satisfy the drawing requirements of the rules outlined under

C.F.R. § 1.83(a). Accordingly, withdrawn of the objection is respectfully requested."

Examiner respectfully disagrees.

The following is a quotation of the 37 CFR § 1.83(a):

(a) **The drawing in a nonprovisional application must show every feature of
the invention specified in the claims**. However, conventional features
disclosed in the description and claims, where their detailed illustration is not
essential for a proper understanding of the invention, should be illustrated in the

drawing in the form of a graphical drawing symbol or a labeled representation
(e.g., a labeled rectangular box). In addition, tables and sequence listings that
are included in the specification are, except for applications filed under 35 U.S.C.
371, not permitted to be included in the drawings. (**Emphasis added**)

While Examiner agrees with the Applicant that Figure 2 references Steps 1-4,

and that those steps are described in the specification, Examiner does not believe that it

is relevant to this argument. Examiner respectfully disagrees with Applicants assertion

that "the specification adequately describes the elements of the claimed invention and,

accordingly, a graphical depiction of the elements in the drawings is not required," and

notes that 37 CFR § 1.83(a) requires that "The drawing in a nonprovisional application

must show every feature of the invention specified in the claims." Since those features

are specified in the claims, they must be shown in the drawings. It is not sufficient for

the features to merely be described in the specification.

Examiner suggest that the Applicant can overcome the current objection by

simply replacing "STEP 1," "STEP 2," "STEP 3" and "STEP 4" in the Figure, with the

appropriate passages in the specification, and if the passages are too lengthy, with their

summaries.

Claims

8.   Applicant's arguments with respect to claims have been considered but are moot

in view of the new ground(s) of rejection.

Conclusion

The examiner requests, in response to this Office action, support be shown for

language added to any original claims on amendment and any new claims. That is,

indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aleksandr Kerzhner whose telephone number is (571)270-1760. The examiner can normally be reached on Mon-Fri 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.K.

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09/11/2007

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